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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,136	11/20/2001	Ylian Saint-Hilaire	042390.P12982	9435

7590 06/16/2005

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EXAMINER

KNAPP, JUSTIN R

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,136

Applicant(s)

SAINT-HILAIRE ET AL.

Examiner

Justin Knapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-16, 19-22, and 26-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Milton, et al (here on Milton), US 2003/0117433.

3. As per claims 1, 6, 31, and 36, Milton teaches

defining a service-specific protocol to facilitate remote control of a service provided by the remote device;

sending data corresponding to the service provided by the remote device via a host-side software module running on a host computer in a format defined by the service-specific protocol from the host computer to the remote device over a network communication link;

sending control commands from the host computer to the remote device based on the service-specific protocol to cause the remote device to perform the service using the data that are sent to the remote device (see entire figures 4 and 5, shows how a host computer remotely controls a remote device).

4. As per claims 2, 10, 13, 32, and 37, Milton teaches wherein the network communication link is established by:

connecting the host computer to a network to which at least one remote device is already connected;

obtaining an IP address for the host computer;

broadcasting a search message over the network requesting that any device meeting a search criteria defined by data contained in the search message to contact the host computer using the IP address for the host computer;

listening for a response to the search message, and in response thereto:

retrieving a description of a service provided by a remote device that responds to the search message to obtain a port number that may be used to communicate with the service; and opening a TCP (transmission control protocol) socket that uses the port number (see sections 0002 through 0005 as well as Figure 3 and corresponding section 0031; these sections explain how the above claimed limitations are a part of the Universal Plug and Play architecture).

5. As per claims 3, 7, 33, 38, and 39, Milton teaches wherein the remote device comprises a display device and the service-specific protocol defines display commands that are used to display content on the display device by sending display commands and data pertaining to the display content from the host computer to the remote device over the network communication link (figure 5 shows a host computer sending display commands to a electronic picture frame).

6. As per claims 4, 8, 34, and 40, Milton teaches wherein the remote device comprises an audio device and the service protocol includes audio commands that are used to playback audio content on the audio device by sending audio commands and audio data pertaining to the audio content from the host computer to the audio device over the network communication link (using

figure 5 as a reference, it is inherent the electronic picture frame is replaceable with an audio device as suggested in section 0005).

7. As per claims 5, 9, and 35, Milton teaches wherein the service provided by the remote device comprises an input service and the service-specific protocol comprises an input protocol defining a plurality of input primitives, further comprising:

listening for input data from the remote device, wherein the input data has a format corresponds to said plurality of input primitives; and

interpreting the input data to generate input commands based on the input protocol (see figure 6, a host computer listens for and interprets input from input data from an electronic picture frame).

8. As per claim 11, Milton teaches wherein a DHCP (Dynamic host configuration protocol) host is connected to the network and obtaining an IP address comprise:

submitting a request from the remote device to the DHCP host for an IP address; and allocating an IP address to the remote device via the DHCP host in response to the request (see section 0033, it is also defined in the UPnP architecture that the use of DHCP is supported).

9. As per claim 12, Milton teaches wherein the remote display device obtains an IP address by performing the operations of:

automatically allocating itself an IP address selected from a predefined range of IP addresses;

verifying that the IP address that is automatically allocated is not used by any other device or host connected to the network, and

if the IP address is already in use, selecting another IP address and repeating the foregoing operations until a unique IP address for the network is obtained (see sections 0002 through 0005 as well as Figure 3 and corresponding section 0031; these sections explain how the above claimed limitations are a part of the Universal Plug and Play architecture).

10. As per claim 14, Milton teaches wherein discovering the service provided by the remote device comprises:

providing a network location from which a description of the service may be retrieved; and retrieving the description of the service from the network location (see figure 5, elements 186-191).

11. As per claims 15 and 21, Milton teaches wherein the service protocol defines feedback primitives that are used to enable the remote device to send feedback data to the host computer (see figure 1, elements 186-192 shows how the remote device sends feedback data to a host computer).

12. As per claim 16, the claim has similar limitations as claims 1 and 3 and is thus rejected on the same grounds as set forth herein above.

13. As per claim 19, Milton teaches wherein establishing the network communication link comprises:

connecting the remote display device to a network to which the host computer is already connected (figure 3);

obtaining an IP address for the remote display device;

broadcasting information pertaining to at least one service provided by the remote display device that includes the IP address over the computer network; and

establishing a network communication link between the remote display device and the host of the remote display device that uses the IP address of the remote display device and an IP address previously assigned to the host computer (see sections 0002 through 0005 as well as Figure 3 and corresponding section 0031; these sections explain how the above claimed limitations are a part of the Universal Plug and Play architecture).

14. As per claim 20, Milton teaches wherein the display service protocol includes display synchronization commands that are sent to the remote device to enable the display content to be refreshed in accordance with a predetermined timing to produce include synchronized animations (see section 0021, it would be inherent that depending on the display being controlled, display content would have to be appropriately refreshed to produce synchronized animations).

15. As per claims 22 and 41, the claim has similar limitations as claims 1 and 9 and is thus rejected on the same grounds as set forth herein above.

16. As per claim 24, Milton teaches wherein the input events correspond to keyboard button activations resulting from a user pressing buttons on a keyboard linked in communication with the remote device (see figure 1, element 18).

17. As per claim 25, Milton teaches wherein the input events correspond to pointer device events resulting from a user activating a pointer device linked in communication with the remote device (see figure 1, element 17).

18. As per claim 26, Milton teaches wherein the input primitives include a custom primitive that is used to pass raw input data received from an input device connected to the remote device

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to the host computer (using figure 6 as a reference, it'd be inherent that input primitives would be able to be customized).

19. As per claim 27, Milton teaches further comprising retrieving information corresponding to an input service provided by the remote device, said information including the primitives used by the input service (see figure 6 to see the retrieval of information corresponding to an input service).

20. As per claim 28, Milton teaches wherein the information is stored in an XML (extended markup language) file that is retrieved by the host computer and parsed to determine the primitives used by the input service (see section 0008).

21. As per claim 29, Milton teaches

establishing a network communication link between the remote device and the host computer;

defining an input service protocol including a plurality of verbal input commands, each input primitive corresponding to a respective input event;

in response to receiving verbal input at the remote device, generating digitized audio data corresponding to the verbal input commands;

sending the digitized audio data to the host computer via the network communication link;

processing the digitized audio data using speech recognition software running on the host computer to determine if the verbal input contains verbal input commands corresponding to the input service protocol; and

using such verbal input commands to control an action of the host computer (see section 0028 which teaches the use of a microphone as an input device. It is inherent that a microphone would be used to form verbal input commands in a similar system as shown in figure 6).

22. As per claim 30, Milton teaches further comprising storing the digitized audio data in a buffer on the remote device prior to sending it to host computer (see figure 1, element 7).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 17-18, 23-25, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milton.

25. As per claims 17-18, applicant(s) numerous definitions of “remote display device” is construed to be an admission that the criticality does not reside in the type of “remote display device” utilized and hence obvious variants of one another.

26. As per claims 23-25 and 42-44, applicant(s) numerous definitions of “input event/device” is construed to be an admission that the criticality does not reside in the type of “input event/device” utilized and hence obvious variants of one another.

Response to Arguments

27. The declaration filed on February 7, 2005 under 37 CFR 1.131 has been fully considered but is ineffective to overcome the Milton reference (US 2003/0117433 A1).

28. Based on the evidence supplied, it appears that applicant is relying on conception prior to the effective date of reference, followed by diligence until the US filing date.

29. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Milton reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Per MPEP 715,

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. **FACTS, not conclusions, must be alleged.** Evidence in the form of exhibits may accompany the affidavit or declaration. **Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.**

A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23, 23, O.G. 1224 (Comm'r Pat. 1883). Similarly a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, **without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.**

When reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes". **An accompanying exhibit need not support all claimed limitations, provided any missing limitation is supported by the declaration itself.** Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out **exactly** what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.")

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

30. The declaration and the accompanying exhibit do not provide enough evidence to support all the claimed limitations prior to the reference date, therefore does not support conception of the claimed invention. For example, there is no explanation of the exhibit or positive statement on the declaration or support the limitation, “wherein a DHCP (Dynamic host configuration protocol) host is connected to the network and obtaining an IP address comprise: submitting a request from the remote device to the DHCP host for an IP address; and allocating an IP address to the remote device via the DHCP host in response to the request.” of claim 11. Applicant did not give a clear explanation pointing out exactly what facts are established and relied upon from the exhibit with respect to this particular limitation. It is noted that neither “we conceived of the invention according to each of independent claims 1, 6, 16, 22, 29, 31, 36, and 41 of the above-captioned patent application in this country” (page 1, paragraph 4 of the declaration) nor Exhibits A, B, and C provide sufficient facts to support the aforementioned limitation in claim 11.

The aforementioned limitation is claim 11 merely provides one example of insufficient evidence supporting conception of the claimed invention. It is to be understood that there are other claimed limitations that are not sufficiently supported by the evidence provided by the declaration and the accompanying exhibit.

31. Per MPEP 715.07(a),

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. Ex parte Kantor, 177 USPQ 455 (Bd. App. 1958).

However, in the interest of compact prosecution, the examiner notes that the evidence submitted is insufficient to establish diligence from a date prior to the effective date of the Milton reference (November 9, 2001) to the US filing date of this application (November 20, 2001) because applicant merely alleged that applicant or patent owner had been diligent without

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being specific as to dates and facts. Applicant merely stated that applicant has been diligent from prior to November 9, 2001 to at least November 20, 2001 without providing an account of activities occurring between November 9, 2001 and November 20, 2001. For example, "Ylian Saint-Hilaire met with patent attorney R. Alan Burnett for an invention disclosure meeting in Hillsboro, Oregon prior to November 9, 2001 to discuss the subject-matter of the above-captioned patent application" represents only one activity, and does not constitute an account of affirmative acts or acceptable excuses occurring between November 9, 2001 and November 20, 2001.

Furthermore, the declared filing date "November 20, 2000" on page 2, paragraph 7 of the Declaration is incorrect.

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, **applicant must show evidence of facts establishing diligence.**

Per MPEP 2138.06,

THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES

An applicant must account for the entire period during which diligence is required. *Gould v Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "has diligently reduced to practice" is not showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.) *Kendall v. Searles* 173 F.2d 98, 993, 81 USPQ 363, 369 (CCPA 1949) (**Diligence requires that applicants must be specific as to dates and facts.**).

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (**Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field.**).

Conclusion

32. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Knapp whose telephone number is (571)272-4149. The examiner can normally be reached on Mon - Fri 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571)272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 12, 2005

Justin Knapp
Examiner
Art Unit 2182



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